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REMARKS

To date, the Examiner has not indicated that the subject matter of the information disclosure statement (IDS) filed November 8, 2005 has been properly considered. A copy of such IDS is submitted herewith. If the Examiner requires additional copies of any reference(s), applicant invites the Examiner to contact the undersigned. Documentation in the file wrapper of the instant application confirming the Examiner's consideration of the reference(s) is respectfully requested.

The Examiner has objected to Claim 1 due to informalities. Applicant has clarified such claim to avoid such objection.

The Examiner has rejected Claims 29, 30 and 37 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner has specifically argued that applicant's claimed "determining if the first file format is...a graphics file format type...the second file format being...the HTML file format type without scripts...if it is determined that the first file format is the graphics file format type" (Claims 29 and 37) is not described in the specification to enable one to make and/or use the invention. The Examiner has also argued that applicant's claimed "certain electronic file received by at least one of a RTP transfer protocol or a HTTP transfer protocol" (Claim 30) is not described in the specification to enable one to make and/or use the invention.

With respect to Claims 29 and 37, applicant respectfully point out paragraph [0025] in the specification which, in part, clearly states:

"For example, if the server computer 122b receives a first file having a word processing file format type and a second file having a graphics file format type, the server computer 122b will determine that the first file having the word processing file format will be converted to a TXT file format, a RTF file format (without scripts), or a HTML file format and that the second file having the graphics file format will be converted to a JPB file format, a BMP file format, a JPEG file format, a GIF file format, or a HTML file format... the server computer 122b may examine the retrieved electronic files and only

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convert those electronic files that do not have the following safe format types: TXT file format; RTF file format (without embedded objects); BMP file format; JPEG file format; CSV file format; JPB file format; GIF file format; HTML file format (without scripts); and ASCII file format.”

Thus, such excerpt discloses converting a file with a graphics file format to an HTML file format and that an HTML file format (without scripts) is a safe format type. With respect to Claim 30, applicant respectfully asserts that such claim has been clarified to avoid such objection.

The Examiner has rejected Claims 1-3, 6, 8-9, 11-21, 23-34, 36-37 and 39-43 under 35 U.S.C. 102(b) as being anticipated by Ji et al. (U.S. Patent No. 5,889,943). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims.

With respect to each of the independent claims, the Examiner has relied on Col. 11, line 14-Col. 12, lines 67, and specifically Col. 12, lines 47-49 and 56-67 in Ji to make a prior art showing of applicant's claimed “converting the electronic file from a first file format to a second file format that is different from the first file format and that prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient, said converting of the electronic file being in response to a determination that the electronic file represents the potential security risk to the computer system” (see the same or similar, but not necessarily identical language in each of the independent claims).

Applicant respectfully asserts that such excerpts only teach “transfer[ing] the mail message with the encoded portions...[with] the viruses deleted...[and] renam[ing] the encode portions of the message containing viruses, [and] stor[ing] the renamed portions as files...and notify[ing] the user of the renamed files and directory path” (emphasis added). Thus, Ji teaches deleting the virus infected portions of a mail message or putting the virus infected portions in a new file and renaming the file. Clearly, since only portions of the file are renamed in Ji, such does not meet applicant's claimed “converting the electronic file.” Furthermore, Ji only teaches that such infected portions are renamed and stored in files. Simply renaming a file does not meet

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any sort of converting the format of a file in the manner specifically claimed by applicant, and especially not where the conversion “prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient” (emphasis added), as claimed.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Ji reference, since all of applicant’s claim language has not been met, as noted above. Nevertheless, despite the foregoing paramount distinctions and in the spirit of expediting the prosecution of the present application, applicant has clarified each of the independent claims to further distinguish the prior art of record. Specifically, applicant has amended each of the independent claims at least substantially as follows:

“receiving an electronic file intended for delivery from a sender to an intended recipient, the electronic file having a first file format with a first file extension;

determining whether the electronic file represents at least a potential security risk to a computer system;

if it is determined that the electronic file represents at least the potential security risk, then forwarding to the intended recipient a notification indicating that the electronic file represents at least athe potential security risk;

receiving from the intended recipient a request to view the contents of the electronic file;

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converting the electronic file from the first file format with the first file extension to a second file format with a second file extension that is different from the first file format with the first file extension and that prevents a computer virus in the electronic file from executing when the converted electronic file is opened by the intended recipient, said converting of the electronic file being in response to a determination that the electronic file represents at least the potential security risk to the computer system; and

making the converted electronic file available for viewing by the intended recipient” (see the same or similar, but not necessarily identical language in each of the independent claims).

Thus, applicant has amended the claims to further emphasize that the file containing the computer virus is converted into a different format such that the file has a different or safe file extension. Thus, the virus in the file with the original file extension is prevented from executing in the converted file with the different or safe file extension.

A notice of allowance or a specific prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 21, the Examiner has relied on Col. 11, line 14-Col. 12, line 67 and specifically Col. 11, lines 48-52 in Ji to make a prior art showing of applicant’s claimed “receiving a second electronic file intended for delivery from another sender to another intended recipient, the second electronic file having a third file format and containing another computer virus; converting the second electronic file to a fourth file format that is different from the third file format and that prevents the another computer virus from executing when the converted second electronic file is opened by the another intended recipient; and making the converted second electronic file available for viewing by the another intended recipient.”

Applicant respectfully asserts that such excerpt does not even suggest a file format, as claimed by applicant, but instead only relates to transmitting a message from the client to the

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server. Applicant also points out the arguments made above with respect to the independent claims which clearly distinguish Ji from applicant's claim language.

With respect to Claims 23-27 et al., the Examiner has relied on Col. 13, lines 21-23; Col. 14, lines 30-38; and Col. 20, lines 22-29 in Ji to make a prior art showing of applicant's claimed "second file format being at least one of a TXT file format, a RTF file format without embedded objects, a BMP file format, a JPEG file format, a CSV file format, a JPB file format, a GIF file format, a HTML file format without scripts, and a ASCII file format" (Claim 23 et al.); "second file format being the HTML file format without scripts (Claim 24 et al.); "second file format being the ACSII file format file" (Claim 25); "second file format being the TXT file format" (Claim 26); and "second file format being a file format having text without scripts" (Claim 27).

Applicant respectfully asserts that such excerpts only relate to the original format of the message, and not to a second file format in the context claimed by applicant, namely where the electronic file is converted from a first file format to the second file format, in the specific manners claimed.

With respect to Claim 29 et al., the Examiner has relied on Col. 13, lines 21-23; Col. 14, lines 30-38; and Col. 20, lines 22-29 in Ji to make a prior art showing of applicant's claimed "determining if the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts if it is determined that the certain file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, the HTML file format without scripts, and a JPEG file format if it is determined that the first file format is the graphics file format type." Applicant again respectfully asserts that such excerpts only relate to an original format of the file, and do not even suggest any sort of converting a file from one format to another, let alone in the specific manner claimed by applicant.

Again, since all of applicant's claim language has not been met, as noted above, a notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

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Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P091/01.049.01).

Respectfully submitted,  
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